

REMARKS

Claims 1-12 have been examined. Applicants are amending the specification to correct some typographical errors and amending claim 1. The amendment to claim 1 is made to correct a typographical error and does not narrow the scope of the original claim. Applicants are also adding new claim 13. Claims 1-13 are all the claims pending in the application.

Applicants thank the Examiner for acknowledging Applicants' claim for priority under 35 U.S.C. § 119(a) - (d) and for further acknowledging receipt of all the certified copies of the priority documents. Applicants also thank the Examiner for considering the reference cited in the Information Disclosure Statement filed September 4, 2001.

Applicants respectfully request that the Examiner and the Draftsperson review the original drawings filed on September 4, 2001.

This Amendment is believed to be fully responsive to each point of objection and rejection raised by the Examiner in the non-final Office action dated May 20, 2002. Accordingly, Applicants respectfully request favorable reconsideration and allowance of the pending claims.

Objection to Drawings

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) because the power supply recited in claim 1 is allegedly not illustrated. Applicants respectfully traverse this rejection.

Figure 16 of Applicants' drawings illustrate a battery 30. Further, as disclosed on page 8, second full paragraph of Applicants' specification, the same or equivalent parts as those shown in Figs. 14 to 16 are designated by the same reference numerals. The paragraph bridging page 8 and page 9 states in part that [c]urrent flow from the battery 30 into the armature 3 via the lead wires 58, the brushes 57, and the commutator pieces 4, so that the starting motor is rotated.

In view of the above, Applicants respectfully request that the objection to the drawings be withdrawn because the power supply of claim 1 is illustrated.

Rejection of Claim 1 under 35 U.S.C. § 103(a) – Yumiyama, Blanchet and Yamada

The Examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,028,381 (hereinafter Yumiyama) and further in view of U.S. Patent No. 5,659,211 (hereinafter Blanchet) and U.S. Patent No. 5,010,264 (hereinafter Yamada). Applicants respectfully traverse this rejection.

Applicants' starter of claim 1 is not rendered obvious by the unlikely combination of Yumiyama, Blanchet and Yamada. Applicants' starter recited in claim 1 provides that the springs press the brushes in the radial, inner direction and that the pressed brushes are attached directly or indirectly to the thermostats to prevent thermal damages. Nowhere in the relied upon prior art are these features disclosed or suggested.

MPEP §2141.02 (8th Edition)(Discovering Source/Cause of a Problem is Part of "As A Whole" Inquiry) states "a patentable invention may lie in the discovery of the source of the problem even though the remedy may be obvious once the source of the problem is identified.

This is *part* of the “subject matter as a whole” which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” One skilled in the art would have recognized that Yumiyama, Blanchet and Yamada, individually or in combination, fail to address the problem solved by Applicants’ invention.

Applicants respectfully remind the Examiner when applying 35 U.S.C. § 103, the claimed invention must be considered as a whole. MPEP §2141 (8th Edition)(Basic Considerations Which Apply to Obvious Rejections). Contrary to this framework, the grounds of rejection support a piecemeal approach towards supporting a *prima facie* case of obviousness that is untenable for the following reasons.

The Examiner alleges that the combination of Yumiyama, Blanchet and Yamada discloses or suggests the starter of claim 1. However, one skilled in the art would not have been motivated to modify or combine these references in the manner suggested by the Examiner.

“There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” MPEP §2143 (8th Edition)(Basic Requirements of a Prima Facie Case of Obviousness) In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 (8th Edition)(Fact That References Can Be Combined or Modified Is Not Sufficient To Establish Prima Faice Obviousness); In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

The Examiner alleges that one skilled in the art would have modified Yumiyama for the purpose of assembling the components all in the same sit which enables to be fitted quicker. (Page 3 of non-final Office action). Nowhere in the prior art is this alleged motivation found and the Examiner has failed to provide Applicants with a citation in the Blanchet specification. Therefore, the Examiner's stated motivation to modify Yumiyama in view of Blanchet is unsupported and not convincing.

Additionally, in view of the problem solved in Blanchet, one skilled in the art would have deemed the carbon brushes 3 allegedly biased radially by springs 31 as inconsequential. Therefore, one skilled in the art would not have been motivated to modify the Yumiyama reference in the manner suggested by the Examiner.

Next, the Examiner alleges that one skilled in the art would have been motivated to modify Yumiyama in view of Yamada because attaching the thermistor to the brush through a terminal increases temperature resistance. Applicants first note that Yamada does not disclose a thermistor attached to the brush(emphasis added). (Page 3 of non-final Office action) Rather, the thermistor is disposed between terminal 22' and brush holder 25.

With respect to the Yamada reference, one skilled in the art would not have even considered this reference, since Blanchet already discloses a thermal protection 5. Col. 3, lines 33-44 of Blanchet discloses a thermal protection component 5 which is adapted to cooperate with the motorised reduction gear unit and to cause it to stop in the event of overheating. For at least these reasons, one skilled in the art would not have been motivated to modify Yumiyama in view of Yamada.

Further, one skilled in the art would have recognized that the alleged improvement over the prior art disclosed in Yamada was to provide the positive coefficient thermistor in a motor cover plate 10, instead of outside or inside the motor case. (see Col. 2, lines 1-27; Summary of Invention). Blanchet provides a thermal protection on carrier plate 1. Therefore, one skilled in the art would not have been motivated to modify Yumiyama in view of Yamada for the reasons provided by the Examiner. More particularly, one skilled in the art would have recognized that Yamada fails to provide any advantage or motivation to further modify the unlikely combination of Yumiyama and Blanchet.

For any and all of the reasons presented above, claim 1 is patentable over Yumiyama, Blanchet and Yamada. Therefore, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claim 3 under 35 U.S.C. § 103(a) - Yumiyama, Blanchet, Yamada and Tajima

The Examiner has rejection claim 3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yumiyama, Blanchet and Yamada as applied to claim 1, and in further view of U.S. Patent No. 5,294,851 (hereinafter Tajima). Applicants respectfully traverse this rejection.

As a preliminary matter, Applicants note an inconsistency in the non-final Office action. Paragraph 9 of the Office action states that claim 2 contains allowable subject matter. Since claim 3 depends on claim 2, then claim 3 should also have been determined by the Examiner to contain allowable subject matter. Therefore, paragraph 7 of the Office action that rejects claim 3

on prior art grounds is inconsistent. In view of the above, Applicants respectfully request that claim 3 be allowed or that a new non-final Office action be issued.

Notwithstanding the above, Tajima fails to compensate for the deficiencies of Yumiyama, Blanchet and Yamada with respect to claim 1 and the acknowledged deficiencies of claim 2. Therefore, claim 3 is patentable at least by virtue of its dependency on claim 1 and claim 2.

Rejection of Claim 4 under 35 U.S.C. § 103(a) - Yumiyama, Blanchet, Yamada and Matsushima

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yumiyama, Blanchet and Yamada as applied to claim 1 and further in view of U.S. Patent No. 5,600,193 (hereinafter Matsushima). Applicants respectfully traverse this rejection.

Matsushima fails to compensate for the deficiencies of Yumiyama, Blanchet and Yamada with respect to claim 1. Therefore, claim 4 is patentable at least by virtue of its dependency on claim 1.

Objection to Claims 2 and 5-12

The Examiner has objected to claims 2 and 5-12 as being dependent upon a rejected base claim, but indicates that these claims would be allowable if rewritten in independent form.

Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 09/944,172

Attorney Docket No. Q65810

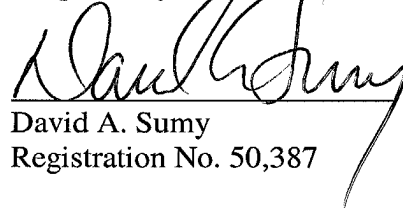
Applicants submit that claims 2 and 5-12 are patentable by virtue of their dependency on claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for any extension of time that may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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